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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91187749
Party	Defendant LICOPAI ENTERPRISES CO., LTD.
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TRADEMARK
3624-0336L

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE TRADEMARK APPLICATION OF

Application No.: 77/266,464
Filed: August 28, 2007
Mark: VALANNA 88 (Stylized)
Class: 3

Published in the Official Gazette
Dated: July 29, 2008

VALANNA COSMETICS, LLC.)
)
Opposer,)
)
v.)
)
LICOPAI ENTERPRISES CO., LTD.)
)
Applicant.)

Opposition No.: 91187749

ANSWER TO NOTICE OF OPPOSITION

Applicant, LICOPAI ENTERPRISES CO., LTD., a Taiwanese corporation with offices located at 1F., No. 98 Ho Ping Road, A Lien Hsiang, Kaohsiung Hsien, TAIWAN, hereby answers the Notice of Opposition filed by Opposer, VALANNA COSMETICS, LLC, a California limited liability company, having a business address of 301 N. Jackson Ave., #D, San Jose, California, 95133, USA, in connection with the above-identified Notice of Opposition dated November 28, 2008 as follows:

1. Applicant admits the allegation set forth in paragraph 1 of the Notice of Opposition, except that the Applicant claims that the first date of use of the mark in commerce as “at least as early as October 20, 2001.”
2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation set forth in Paragraph 2 of the Notice of Opposition and accordingly denies the allegations and leaves Opposer to its proofs.
3. Applicant admits the allegation set forth in Paragraph 3 in the Notice of Opposition.
4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 4 of the Notice of Opposition and accordingly denies the allegation and leaves Opposer to its proof.
5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 5 of the Notice of Opposition and accordingly denies the allegation and leaves Opposer to its proofs.
6. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 6 of the Notice of Opposition and accordingly denies the allegation and leaves Opposer to its proofs.
7. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegation in paragraph 7 of the Notice of Opposition and accordingly denies the allegation and leaves Opposer to its proofs.

FIRST BASIS OF OPPOSITION

8. Applicant denies the allegation set forth in paragraph 8 of the Notice of Opposition.

SECOND BASIS OF OPPOSITION

9. Applicant denies the allegation set forth in Paragraph 9 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

I. Applicant is the True Owner of the mark “ VALANNA 88”

1. Since long prior to the first use by Opposer, Applicant has continuously used the marks, “88,” “VALANNA” and “VALANNA 88 (stylized)” in connection with cosmetic products in foreign commerce between Taiwan and the United States.
2. Applicant is the owner of the trademark “88” in Taiwan since November 1, 1977, and the mark “VALANNA” and similar marks, under Registration nos. 134473, 134504, 158417, 293585, 514013, 651140, 991905, 991906, 92795, 231380, 241918, 819030, 731964, in Taiwan since June 16, 1980; and the mark “88 and VALANNA” in Taiwan since August 16, 1994, through it's predecessor Shie Ching Hsien Chemical Industrial Co., Ltd., a Taiwanese Corporation.

3. Applicant, through its predecessor, has advertised the mark “VALANNA 88 (stylized)” in connection with cosmetic products in the United States in magazines, newspapers, and other advertising materials, and spent the advertising expenditure in the United States.
4. Applicant is also the current owner, through its predecessor, Shie Ching Hsien Chemical Industrial Co., Ltd., of trademark registrations for the marks “VALANNA 88” and “VALANNA” used for cosmetics in China, Hong Kong, Vietnam and Thailand.
5. Applicant is the owner of U.S. Trademark Application No. 77/266,464, filed August 28, 2007, in the U.S. Patent and Trademark Office for the mark “VALANNA 88 (Stylized).”
6. Applicant is also the owner of U.S. Trademark Application No. 77/473,494 filed on May 13, 2008, in the U.S. Patent and Trademark Office for the mark “VALANNA.”
7. The Applicant’s marks are symbolic of extensive goodwill and consumer recognition built up by the Applicant through a substantial amount of time, effort and expense in promoting and selling goods using the Applicant’s marks. Therefore, the Applicant’s marks have become distinctive and famous among its customers.

8. Applicant was approached by the Mr. David Lieu, the Respondent in Cancellation proceeding No. 92048204 requesting a distribution contract of the Applicant's cosmetic products under the mark "VALANNA 88" in 2002, and was turned down by Applicant.
9. Mr. David Lieu, the Respondent in Cancellation No. 92048204, with a business address of 1864 Spring Song Drive, San Jose, California 95131, filed a trademark application on October 24, 2002 for the mark "VALANNA 88" in conjunction with cosmetics, namely, cosmetic skin creams and lotions, powders for the face and body, toilet waters, lipstick, rouge, eyebrow pencil, eye shadow, hair conditioning creams, hair grooming creamspomade, hair grooming oil, permanent wave solutions, hair and scalp conditioning oils, hair dyes, perfumes, and mascara. The registration was issued on January 18, 2005.
10. Respondent in Cancellation No. 92048204 claimed that the date of first use of the mark "VALANNA 88" set forth in cancelled Registration No. 2,919,810 in connection with the goods listed in the registration was as at least as early as November 30, 2002 in the United States. A Statement of Use was filed by the Respondent on October 13, 2004.

11. Opposer in the name of VALANNA COSMETICS, LLC filed a new trademark application for U.S. Trademark Application No. 77/622,605 for the mark "VALANNA 88" in conjunction with "cosmetic skin creams" on November 26, 2008, which is the same mark as the cancelled mark as set forth in U.S. Registration No. 2,919,810, after Mr. Lieu filed a Voluntary Cancellation on April 14, 2008, the same day when the Applicant was travelling to San Jose to take the deposition of Mr. Lieu.
12. Opposer fraudulently declared in the '605 application, that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance as to be likely, when used on or in connection with goods/services of such other person, to cause confusion, to cause mistake, or to deceive."
13. Although Registration No. 2,919,810 was voluntarily cancelled by Mr. David Lieu, the Respondent in Cancellation No. 92048204, the Opposer, VALANNA COSMETICS, LLC with Mr. Lieu as one of the partners, filed a new trademark application for the same mark as the cancelled mark as set forth in U.S. Registration No. 2,919,810 based on use of the mark in commerce and the Opposer's mark is identical to the Applicant's mark in

appearance, pronunciation, and trade connotation. Therefore, the Opposer's mark would cause confusion, deception, and mistake with the Applicant's mark, all to the Applicant's damage.

14. The goods set forth in the Opposer's pending application no. 77/622,605 and claimed in the present Notice of Opposition, namely, cosmetic skin cream, is closely related to the goods used under the Applicant's mark namely, cosmetics; facial creams; cosmetic lotion; perfumery; lipsticks; facial cleanse; all purpose cleaning preparation ; essential oils; bar soap, deodorant soap, perfumed soap, antibacterial soap; cosmeceutical; eye lotions; mascara; body lotion, facial lotion, shaving lotions, sun care lotions; beauty masks, rouge, eyebrow pencil, in International Class 3. It is believed that such use of the Opposer's mark is likely to cause confusion, deception and mistake all to the Applicant's damage.

15. The Opposer is not the true owner of the mark "VALANNA 88" or any similar mark including the word "VALANNA," or "88."

II. Fraud

16. On information and belief, Opposer committed fraud in filing Application No. 78/178, 241 which matured into Registration No. 2,919,810 and was later cancelled in a cancellation proceeding, when David Lieu, the Respondent in the cancellation proceeding, claimed that he believed that he is the owner of the Trademark sought to be registered and no other person, firm, corporation, or association has the right to use the mark in commerce in the application documents, all to the damage of the Applicant, since Mr. Lieu visited the Applicant in Taiwan in 2002.
17. On information and belief, Opposer committed fraud in filing Application No.: 77/622,605 when the Opposer claimed that he was the owner of the Trademark sought to be registered and no other person, firm, corporation, or association has the right to use the mark in commerce in the application documents, after U.S. Trademark Registration No. 2,919,810 was cancelled, all to the damage of the Applicant, since Mr. Lieu visited the Applicant in 2002, and since Mr. Lieu knew the Applicant in the Cancellation Proceeding.


WHEREFORE, Applicant having fully and completely answered said Notice of Opposition, prays that the Notice of Opposition should be dismissed.

Respectfully submitted,

LICOPAI ENTERPRISES CO., LTD.

Date: January 5, 2009

By:



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Registration No. 28,380

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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing Answer to the Notice of Opposition has been served upon counsel for the Opposer:

Jennifer DeArmond
Schneck & Schneck
P.O. Box 2-E
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via first-class mail, postage prepaid, on this 5th day of January, 2009.

By Tiffany C. Johnson
Tiffany Johnson